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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,792	12/21/2000	Toshiro Kisakibaru	SON-1973	6413

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RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/740,792	Applicant(s) KISAKIBARU, TOSHIRO	
	Examiner Vivek D Koppikar	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 20-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. This communication is in response to the application filed on December 21, 2000 which claims priority to two Japanese applications filed on December 28, 1999 and September 27, 2000. As of the date of this communication no Information Disclosure Statement (IDS) statement has been filed in this case. Claims 1-25 are pending in this application and have been examined.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-19, drawn to a home doctor system, classified in class 705, subclass 2.
 - II. Claims 20-25, drawn to blood processing apparatuses, classified in class 600, subclass 576.
3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a blood processing apparatus (capsule or injection appliance) in a non-computerized or non-electronic home doctor system. See MPEP § 806.05(d).
4. During a telephone conversation with Ronald Kananen on July 15, 2004 a provisional election was made with traverse to prosecute the invention of I, claims 1-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-25 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word “helpful” in line 2 of render the claim indefinite. It is not clear what information is considered “helpful” and what information is considered not “helpful” from reading the specification. Appropriate correction and/or clarification is required.

For the purposes of examination, the examiner will interpret this claim to mean that any information provided from a prior art system to a subscriber relating to the prevention or treatment of diseases is “helpful.”

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

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reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1 and 13-17 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Number 6,184,030 to Katoot.

Katoot is directed towards biologically-active polymers.

As per claim 1, which is directed towards a home doctor system, Katoot teaches data that can be transmitted between a home doctor center and a plurality of subscribers, wherein each subscriber measures his or her physical condition data with a physical monitoring device and sends it to the home doctor center and the home doctor center makes an initial diagnosis of the subscriber's physical condition from the physical condition data, and informs the subscriber of the result of the initial diagnosis (Col. 16, Ln. 60-Col. 17, Ln. 32).

As per claim 13, in the system of Katoot the physical condition data or the results of the blood tests are processed by software for initial diagnosis (Col. 17, Ln. 13-20).

As per claim 14, the system of Katoot can inform a medical institute of a result of the initial diagnosis (data can be transmitted) (Col. 17, Ln. 19-32).

As per claim 15, the system of Katoot gives each subscriber advice in addition to the result of the initial diagnosis (Col. 17, Ln. 29-32).

As per claims 16-17, the system of Katoot supplies each subscriber with additional information based on a result of the initial diagnosis (Col. 17, Ln. 29-32).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoot.

As per claim 2, which is directed towards a home doctor system, Katoot teaches a home doctor system where data can be transmitted between a home doctor and a plurality of subscribers. The home doctor center makes an initial diagnosis of the subscriber from the results of the blood test and informs the subscriber of the result of the initial diagnosis (Col. 16, Ln. 60-Col. 17, Ln. 32).

In Katoot the patient rather than the home doctor center executes the blood tests. However the step of the patient (or subscriber) sending his or her own blood to the home doctor center is well known in the art and the examiner takes Official Notice. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Katoot so that the subscriber would have been required to send the blood to a testing center for testing rather than do his or her own testing with the motivation of providing the patient with more accurate tests rather than the amateur tests that would have been performed by the patient.

Further, since the knowledge of sending samples to a testing center for testing, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

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As per claim 3, which is directed towards a home doctor center, Katoot teaches a home doctor system wherein results of a test are registered in a database and the initial diagnosis of the subscriber (patient) is made on the basis of the results of the test (Col. 16, Ln. 60-Col. 17, Ln. 32).

In Katoot the patient rather than the home doctor center executes the blood tests. However the step of the patient (or subscriber) sending his or her own blood (from the blood-collecting site) to the home doctor center (blood testing center) is well known in the art and the examiner takes Official Notice. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Katoot so that the subscriber would have been required to send the blood to a testing center for testing rather than do his or her own testing with the motivation of providing the patient with more accurate tests rather than the amateur tests that would have been performed by the patient.

Further, since the knowledge of sending samples to a testing center for testing, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

As per claim 4, in the system of Katoot the blood-collecting site is a subscriber's residence (home) (Col. 16, Ln. 60-63).

As per claim 5, in the system of Katoot the blood-collecting stand (kit) is placed in a station or other readily accessible location (home) (Col. 16, Ln. 60-63).

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As per claim 6, in the system of Katoot comprises a delivery/gathering system for delivering blood capsules to the blood-collecting site, and gathering capsules containing blood and sending them to the blood test center (Col. 16, Ln. 60-Col. 17, Ln. 10).

As per claim 8, in the system of Katoot the home doctor system does not arrange a visit of a qualified person to a residence when the home doctor system accepts a blood collection request from the blood-collecting site. However this feature is well known in the art and the examiner takes Official Notice. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an option wherein the home doctor center arranged a visit of a qualified person to a residence when the home doctor center accepted a blood collection request from the blood-collecting site with the motivation of providing the user (patient) with a convenient means of having their blood samples collected (without having to burden the user to bring their blood samples to a testing center).

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katoot as applied to Claim 3, above, and in further view of US Patent Number 5,960,403 to Brown.

Katoot fails to teach the step of labeling and coding the blood samples; however, this feature is well known as evidenced by Brown. Brown is directed towards a health management process control system. Brown teaches the concept of providing each patient (or the sample of each patient) with an identification code (Col. 9, Ln. 6-16). At the time the invention was made one of ordinary skill in the art would have been motivated to include an identification code on the blood samples in Katoot with the motivation of ensuring that samples from different patients were not mixed up.

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13. Claims 9 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoot as applied to Claim 1 above and in further view of US Patent Number 5,752,236 to Sexton.

Katoot fails to teach that the information obtained by the home doctor center is used for the calculation of premiums wherein the risk of payments of insured amounts to individual subscribers are calculated, and premiums are determined based on the calculated risks. Katoot also fails to teach the concept of modifying the premium in response to changes in the calculated risks; however these features are well known in the art as evidenced by Sexton, which is directed towards a life insurance system and method. Sexton teaches that premiums are determined by considering such as expenses and mortality (Col. 9, Ln. 56-64). (e.g. If the blood tests indicate a predisposition to a great number of diseases this is likely to result in a higher number of claims).

At the time the invention was made one of ordinary skill in the art would have been motivated to add this feature to Katoot whereby the information obtained from the home doctor tests is used to calculate the risks and premium and the premiums are modified in response to changes of the calculated risks with the motivation of providing a more efficient and up to date means of calculating a patient's insurance premium.

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katoot as applied to Claim 1 above and in further view of Fu.

Katoot fails to teach or suggest monitoring blood pressure and pulses; however these features are well known in the art as evidenced by Fu. Fu, which is directed towards a personal health monitor, teaches a means of measuring blood pressure and pulse rates (Figure 8 and Col. 10, Ln. 28-53). At the time the invention was made, one of ordinary skill in the art would have

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been motivated to add these features to the home doctor system of Katoot in order to provide a patient with more additional information on their vital signs indicative of their physical condition (Col. 1, Ln. 41-51).

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katoot as applied to Claim 2 above and in further view of US Patent Number 6,180,338 to Adams.

Katoot does not teach a feature wherein a subscriber's gene is decoded and the decoded genetic information is stored as a database to use if for predicting and preventing possible diseases of the subscriber and for the treatment of such diseases; however, these features are well known in the art as evidenced by Adams which is directed towards a method, reagent and kit for the detection and amplification of nucleic acid sequences (Col. 21, Ln. 65-Col. 22, Ln. 7). (Katoot does teach the step of storing data once it has been received (Col. 17, Ln. 13-17).

At the time the invention was made one of ordinary skill in the art would have been motivated to modify the system of Katoot and add this feature whereby the decoded genetic information, stored in a database, was used for predicting and preventing diseases with the motivation of providing the user with a means by which they would be informed ahead of time, before they were affected by a disease, so that they could take appropriate preventive action.

16. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katoot as applied to Claim 1.

The home doctor system of Katoot does not recite a database to store data on each subscriber. However, this feature is well known in the art and the Examiner takes Official Notice of the use of a database to store subscriber data. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included a database within the home

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doctor system of Katoot with the motivation of providing a means to securely store the subscriber data.

Further, since the knowledge and use of database for storing subscriber data , in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Vivek Koppikar** whose telephone number is **(703) 305-5356**. The examiner can normally be reached on Monday-Friday from 8 AM to 5 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9306.

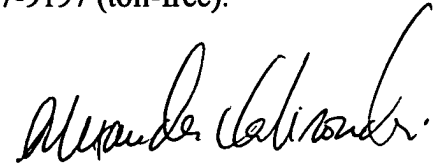
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Vivek Koppikar

8/9/04



ALEXANDER KALINOWSKI
PRIMARY EXAMINER